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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,638	07/30/1999	EIJI KAWAI	450127-02126	9709
20999	7590	06/24/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			PEYTON, TAMMARA R	
			ART UNIT	PAPER NUMBER
			2182	

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/364,638

Applicant(s)

KAWAI, EIJI

Examiner

Tammara R Peyton

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 45-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 46, 52, and 54 recites the limitation "wherein said information processing apparatus further comprising *a display*". Nowhere in the specification does the information processing apparatus further comprise of a display. See Figs. 1, 5, 6, and 10. Throughout the specification the information processing apparatus comprises of a video game console that may be connected to a display, but the information processing apparatus itself does not comprise of a display. There is insufficient antecedent basis for this limitation in the claim.

Claims 48 and 59 recite the limitation "said display". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 45, 47, 49-51, 53, 55-58, and 60-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hsu*, patent number 5,785,598.

2. As per claims 45, 55, *Hsu* teaches an information processing apparatus (Fig.2) comprising:

- a processor (CPU, 11, Fig.2) for executing a booting program (BIOS) to start up said information apparatus; and
- a data store (ROM, 21, Fig.2) for storing first data,
- wherein said processor selectively uses said first data stored in said data storage or second data (ROM, 22, Fig. 2) stored in another data storage according to said booting program to start up said information processing apparatus, said other data storage being capable of data communication with said information processing apparatus. (Abstract, cols. 2, lines 14-col. 5, lines 1-37)

3. *Hsu* teaches wherein said processor selectively executes using either a first data store, from an existing game cartridge, (200, Figs. 1, 2) or a second data store, from add-on card (300, Fig.2) according to said booting control program stored in the information processing apparatus BIOS ROM. (col. 4, lines 6-16) It would have been

Art Unit: 2182

obvious to one of ordinary skill at the time the invention was made that *Hsu's* BIOS ROM includes BIOS program code that implements a software routine to load a boot program for starting up said information processing apparatus. *Hsu* also teaches wherein said other data storage is capable of data communication with said information processing apparatus.

4. As per claims 51 and 61, *Hsu* teaches information processing apparatus (Fig.2) comprising:

- a processor (CPU, 11, Fig.2) for executing a booting program (BIOS) to start up said information apparatus; and
- a communication unit (obvious) for data communication with a plurality of data storages for storing data, at least one of said data storages being capable of data communication with said information processing apparatus,
- wherein said processor selectively uses said data stored in said plurality of data storages according to said booting program to start up said information processing apparatus. (Abstract, cols. 2, lines 14-col. 5, lines 1-37)

5. As per claim 65-84 *Hsu* teaches a method of starting up an information processing apparatus, with a recording medium removably inserted therein, comprising the steps of:

- transmitting boot data, to be executed according to a boot sequence by an information processing apparatus which executes a program to process data, stored in a recording medium (smart card, 300b, Fig. 3b) that is removably inserted in the information processing apparatus to the information processing apparatus; and
- booting the information processing apparatus according to the booting sequence based on said boot data transmitted from said recording medium.

5. As per claims 47 and 58, *Hsu* teaches wherein the first data storage includes at least one of image data and sound data but does not expressly teach wherein the other data storage for storing said second data is a recording medium removably connected to said information processing apparatus also includes image and sound data.

However, *Hsu* teaches wherein the second data storage includes additional image programs related to the first data storage, therefore, one of ordinary skilled in the art would readily recognize that the second data storage would also include additional programs including at least one image data and sound data related to the first data storage.

6. As per claims 50, 53, 60, and 63, *Hsu* teaches wherein the other data storage is a portable electronic device (Smart card, 300b, Fig. 3b)

Art Unit: 2182

7. As per claims 56, 62, and 64, *Hsu* teaches wherein said first and second data are image data and displaying an image of the selected image data on a display according to said booting program in starting up said information processing apparatus.

8. As per claim 57, *Hsu* teaches wherein the other data storage is a recording medium removably connected to said information processing apparatus.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (703) 306-5508. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin, can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231.



Art Unit: 2182

Faxes for Official/formal (After Final) communications or for informal or draft communications (please label "PROPOSED" or "DRAFT" or "OFFICIAL") sent to:

(703) 872-9306

Hand-delivered responses should be brought to:

USTPO, 2011 South Clark Place, Customer Window  
Crystal Plaza Two, Lobby Room 1B03, Arlington, VA, 22202 Crystal Park II, 2121.

A handwritten signature in cursive script, appearing to read "Tammara Peyton", with a long, sweeping horizontal line extending to the right.

Tammara Peyton

June 18, 2003